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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,096	03/12/2004	Richard M. Hogan	4022-000014	8094
27573 7590 01/06/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
DESAL, ANISH P				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/800,096

**Applicant(s)**

HOGAN ET AL.

**Examiner**

ANISH DESAI

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-30 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-30 and 47-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's arguments in response to the Office action dated 07/14/08 have been fully considered.
2. The objection to the specification is withdrawn in view of Applicant's amendment and response.
3. The double patenting rejection is withdrawn in view of Applicant's amendment and response.
4. The 35 USC Section 112-first paragraph rejection is withdrawn in view of Applicant amendment and response.
5. In view of newly added amended claims, a new 35 USC Section 112 -first and second paragraph rejections are made.
6. All of the previously made art rejections are maintained.
7. In view of the newly added amendment to claims, a new 35 USC Section 103(a) rejection based on Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167) and Cadwell et al. (US 3,581,884) is made.
8. Support for the newly amended claims 29 and 52 is found in the specification as originally filled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 22-30 and 47-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
10. Newly amended claims 22 and 47 require that the expendable layer A is made of a single polymeric material and a single polyolefin material respectively. Specification as originally filled does not support this limitation. It is noted that Applicant has submitted in his/her response that paragraph 0029 of the specification supports the aforementioned limitation. However, the Examiner respectfully submits that paragraph 0029 does not provide the support for aforementioned limitation. Specifically, it is noted that the recitation "it is common to co-extrude the same material in adjacent ports in order to build up thickness" as recited in the aforementioned paragraph can not be interpreted to mean "a single" polymeric material. Co-extrusion of same material does not necessarily mean that a layer is made of a single polymeric material.
11. If Applicant wishes to claim a single polymeric material then the claim language should be recited as "A is an expendable polymeric layer **consisting** of a polymeric material".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. It is noted that the aforementioned claims depend from an independent claim 22, which requires that the layer A be made of a single polymeric material. However, claims 24 and 25 recite "wherein A **comprises** a polyethylene". The phrase "comprises" is open-ended and it is interpreted as there can be an additional polymeric material present in the layer A. Therefore, claims 24 and 25 are in conflict with claim 22.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 22-24, 26, 28-30, 47, 48, and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167).

15. The Examiner respectfully submits that claims as presently recited are open to the presence of additional layers in a composite sheet besides layers A and B.

16. Regarding claims 22-24, 47, and 48, Takahira discloses a pressure-sensitive adhesive sheet having a multilayer release liner (4, 4) applied on both sides of a layer of pressure sensitive adhesive 5 (see abstract, Figure 2, and column 6 lines 26-45). The release liner of Takahira as shown in Figure 2 includes a release functioning layer 1 that is on both sides of the PSA layer 5. Further, at column 3 lines 30-35, Takahira discloses that the release functioning layer 1 is made of liner low-density polyethylene. The Examiner equates the release functioning layer 1 of Takahira as Applicant's expendable polymeric layer A made of a single polymeric material as claimed.

17. Alternatively with respect to claim 22, it is noted that this claim does not specify a composition of the expendable polymeric layer A. Further, Comparative Example 1 of Takahira discloses that a PSA tape was made as in the Example 1, except a silicone-treated PET separator was used instead of the laminated (three layered) release liner. This disclosure of Takahira is interpreted to read on the structure of PSA tape having PET liner/adhesive/PET liner, and it meets Applicant's A-B-A composite sheet, wherein layer A is an expendable polymeric layer made of a single polymeric material.

18. With regards to the claim limitation of "co-extruded A-B-A composite sheet", the phrase "co-extruded" is interpreted to be a product-by-process limitation. The product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself.

The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

19. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir.1983).

20. In the instantly claimed subject matter, a three-layer A-B-A composite sheet of Applicant comprises an expendable polymeric layer A and a thermoplastic adhesive layer B. Further, the claim language does not explicitly exclude other layers from being present in the three-layer A-B-A composite sheet. Moreover, the presently claimed invention requires that layer A be made of a single polymeric material (or a single polyolefin material) capable of being readily separated from the adhesive layer B. The adhesive sheet (composite sheet) of Takahira is previously disclosed and it includes an adhesive layer 5 (layer B) that is covered on both sides with a release liner (4, 4) (Figure 2). Further, the release liner (4, 4) of the adhesive sheet of Takahira includes a release functioning layer 1 (layer A) that is functionally capable of being readily separated from the adhesive layer 5 (abstract). The Examiner sees no unobvious difference between the claimed composite sheet and that of Takahira.

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21. Regarding claims 22, 26, and 47, the difference between the claimed invention and the prior art of Takahira is that Takahira is silent as to teaching a thermoplastic adhesive layer and the adhesive layer comprising a thermoplastic polyurethane.

22. However, Gerard discloses a pressure sensitive adhesive composition and articles containing the pressure sensitive adhesive composition; wherein the PSA composition of Gerard comprises thermoplastic polyurethane (abstract). According to Gerard, the PSA based on thermoplastic polyurethane has a better tack and cohesion properties and exhibits enhanced stability (column 1 lines 34-45).

23. It is noted that the primary reference of Takahira discloses that no particular limitation is imposed on the pressure sensitive adhesive (column 5 lines 13-17).

24. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the thermoplastic polyurethane of Gerard in the invention of Takahira, since Takahira's invention imposes no particular limitation on the pressure sensitive adhesive (column 5 lines 13-17) and one would have used such a thermoplastic polyurethane adhesive with a reasonable expectation of success because such adhesive provides better tack, cohesion properties, and enhanced stability.

25. Regarding claims 28, 50, and 52, it is noted that the thickness of the release functioning layer 1 of Takahira is 2 to 100 micrometers, which reads on Applicant's claimed thickness of 0.003 inches (76.2 micrometers) to 0.010 inches (254 micrometers).

26. Regarding claims 29 and 52, it is noted that the thickness of the PSA sheet of Takahira is from 1 to 200 micrometers (column 6 lines 5-8), which reads on Applicant's



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thickness of 0.005 inches (127 micrometers) to 0.09 inches (2,286 micrometers).

Further, the secondary reference of Gerard as set forth previously discloses a thermoplastic polyurethane adhesive. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the thermoplastic polyurethane of Gerard in the invention of Takahira with the thickness as taught by Takahira, since Takahira's invention imposes no particular limitation on the pressure sensitive adhesive (column 5 lines 13-17) and one would have used such a thermoplastic polyurethane adhesive with a reasonable expectation of success because such adhesive provides better tack, cohesion properties, and enhanced stability.

27. Regarding claim 30, it is reasonable to presume that this imitation is present in the invention of Takahira as modified by Gerard. The support for said presumption is based on the fact that the three layer A-B-A composite sheets of Applicant and that of Takahira as modified by Gerard include expendable polymeric layer A and a thermoplastic adhesive layer B. Further, the expendable polymeric layers A of Applicant and that of Takahira as modified by Gerard are capable of being readily separated from the adhesive layer. Therefore, the aforementioned claim limitation would be present in the invention of Takahira as modified by Gerard. The burden is respectfully shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594).

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28. Claims 25, 49, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167) as applied to claims 22, 47, 52 above, and further in view of Caldwell (US 3,581,884).

29. Takahira as modified by Gerard is silent as to teaching A comprises a polypropylene and A is made of polypropylene as presently claimed.

30. However, Caldwell discloses a plastic film PSA tape, wherein the adhesive layer 8 of Caldwell is covered with a dry-strippable release liner (abstract). At column 4 lines 40-50, Caldwell discloses "Another suitable liner is a matte finish nonpigmented **polypropylene** film...frosty surface."

31. Therefore, it would have been obvious to select polypropylene film as a release functioning layer (expendable layer A) as taught by Caldwell, because selection of a known material based on its suitability for its intended use establishes a *prima facie* case of obviousness.

32. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahira et al. (US 6,395,360B1) in view of Gerard et al. (US 5,929,167) as applied to claim 22 above, and further in view of Schacht et al. (US 5,096,777).

33. Takahira as modified by Gerard is silent as to teaching the adhesive layer comprises a plurality of individual adhesive sheets.

34. However, Schacht discloses a double-sided adhesive tape without a backing (see title). The disclosure of Schacht beginning at column 2 lines 19 to column 2 lines

45 is interpreted as Schacht disclose plurality of individual adhesive sheets that are covered on both sides with a release paper.

35. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plurality of individual adhesive sheets, motivated by the desire to enhance the strength of the adhesive tape.

### ***Response to Arguments***

36. Applicant's arguments filed on 09/25/08 have been fully considered but they are not persuasive.

37. Applicant essentially argues that Takahira reference does not teach a release liner made of a single polymeric material as recited in the presently claimed invention. According to Applicant, Takahira's release liner includes three layers.

38. The Examiner respectfully disagrees for the following reasons:

39. As stated previously, the presently claimed invention can have additional layers in addition to layers A and B. This is further evidenced by Applicant's claim 27 which requires that the adhesive layer comprises a plurality of individual adhesive sheets. Based on this interpretation, the Examiner is equating the release functioning layer 1 of Takahira as Applicant's expendable polymeric layer A, and the PSA layer 5 to Applicant's adhesive layer. Additionally, the release functioning layer 1 of Takahira is made of a linear low-density polyethylene film, which meets claim requirement of a single polymeric material and a single polyolefin material as claimed. Accordingly,

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Applicant's arguments are not found persuasive for patentability and the art rejections are sustained.

40. The Examiner recognizes Applicant's intention to claim a composite sheet having three layers only, however it is respectfully submitted that at present the claim language fails to clarify Applicant's intention.

### ***Conclusion***

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

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44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./  
Examiner, Art Unit 1794

/Hai Vo/  
Primary Examiner, Art Unit 1794